REMARKS

Claims 1-24 were examined and reported in the Office Action. Claims 1-24 are rejected. Claims 1, 5, 6 9 and 21 are amended. New claims 25-29 are added. Claims 1-29 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. § 102(b)

It is asserted in the Office Action that claims 1-24 are rejected under 35 U.S.C. § 102(b), as being anticipated by U. S. Patent No. 5,872,588 issued to Aras et al. ("Aras"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2131, "'[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990))."

Applicant's amended claim 1 contains the limitations of "[a]n apparatus comprising: a first processor coupled to a communications channel device, the communications device capable of receiving and transmitting information to a video-on-demand (VOD) service provider; a VOD content decoder coupled to the first processor; a video and audio formatting processor coupled to the first processor and the content decoder; and an index memory coupled to the first processor, wherein the index memory stores a plurality of VOD program segment representations of at least one partial VOD program content based on at least one user selectable recording of the at

least one partial VOD program content where the at least one partial VOD program content has already been viewed."

Applicant's amended claim 9 contains the limitations of "[a] system comprising: a video-on-demand (VOD) service provider coupled to a plurality of set-top-box (STB) units, wherein each of the plurality of STB units comprises a first processor coupled to a communications channel device, the communications device capable of receiving and transmitting information to a VOD service provider; a VOD content decoder coupled to the first processor; a video and audio formatting processor coupled to the first processor and the content decoder; and an index memory coupled to the first processor, wherein the index memory stores a plurality of VOD program segment representations of at least one partial VOD program content based on at least one user selectable recording of the at least one partial VOD program content where the at least one partial VOD program content has already been viewed, and each of the plurality of STB units are capable of communicating with each other."

Applicant's original claim 17 contains the limitations of "[a] method comprising: ordering at least one video-on-demand (VOD) program from a VOD service provider from a first set-top-box (STB) unit; playing at least one VOD program; selecting a start and stop time for recording a representation of a segment of the at least one VOD program, wherein the start and stop time are user selectable; converting a VOD program identifier of the at least one VOD program to a text representation; one of converting the text representation of the VOD program identifier of the at least one VOD program into a unique encoded digital representation and receiving a unique encoded digital representation from the VOD service provider; converting the start and stop time for a segment of the at least one VOD program to a digital representation; and storing the VOD program identifier encoded digital representation and the start and stop digital representation in an index memory."

Applicant's amended claim 19 contains the limitations of "[a] program storage device readable by a machine comprising instructions that cause the machine to: order at least one video-on-demand (VOD) program from a VOD service provider from a first set-top-box (STB) unit; convert a VOD program identifier of the at least one VOD

program to a text representation; one of convert the text representation of the VOD program identifier of the at least one VOD program into a unique encoded digital representation and receive a unique encoded digital representation from the VOD service provider; <u>convert a start and stop time for at least one segment of the at least one VOD program to a digital representation, where the start and stop time for the at least one segment of the at least one VOD program are user selectable and are based on a stop and a start time of a recorded representation of the at least one segment of the at least one VOD program where the at least one segment of the at least one VOD program has already been viewed;</u> and store the VOD program identifier encoded digital representation and the start and stop digital representation in an index memory."

Aras discloses an apparatus and method for providing a universal audio-visual identification code embedded in audio-visual content. The code is used for collecting and returning to a behavior collection center for processing, such as user viewer habits. Aras, however, does not teach, disclose or suggest "the index memory stores a plurality of VOD program segment representations of at least one partial VOD program content based on at least one user selectable recording of the at least one partial VOD program content where the at least one partial VOD program content has already been viewed," "the index memory stores a plurality of VOD program segment representations of at least one partial VOD program content based on at least one user selectable recording of the at least one partial VOD program content where the at least one partial VOD program content has already been viewed, and each of the plurality of STB units are capable of communicating with each other," "selecting a start and stop time for recording a representation of a segment of the at least one VOD program, wherein the start and stop time are user selectable" or "convert a start and stop time for at least one segment of the at least one VOD program to a digital representation, where the start and stop time for the at least one segment of the at least one VOD program are user selectable and are based on a stop and a start time of a recorded representation of the at least one segment of the at least one VOD program where the at least one segment of the at least one VOD program has already been viewed."

Aras only records a user's habits. Aras may record when a user might record or pause a program, but Aras does not teach that the start and stop segments are from a recorded show that has already been viewed after a user selects the start and stop times.

Further, regarding claims 16, 19, 20, 23, 24 and new claim 25, nowhere in Aras is it taught, disclosed or suggested that a user can send a VOD program segment representation as an electronic mail (email) attachment to another set-top-box unit located at a different venue. In fact, the terms mail, e-mail, email, electronic mail, etc. are nowhere to be found in Aras. And where the term "message" is used does not teach, disclose or suggest a "message" can be communicated from one home station to any other home stations.

Additionally, it is asserted in the Office Action that "Aras discloses ... each of the plurality of STB units are capable of communicating with each other." The Office Action cites Figures 1A-B and column 4, lines 40-57, and column 5, lines 39-67. Nowhere in this citation or throughout Aras, however, is it disclosed that a home station can communicate with other home stations. The only communication by a home station as disclosed by Aras is receiving a audio-visual or VOD from the service provider complex and the home station can provide information from itself to the distribution node or behavior collection center. (Aras, column 5, lines 57-58).

Therefore, since Aras does not disclose, teach or suggest all of Applicant's claims 1, 9, 17 and 21 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b) has not been adequately set forth relative to Aras. Thus, Applicant's claims 1, 9, 17 and 21 are not anticipated by Aras. Additionally, the claims that directly or indirectly depend on claims1, 9, 17 and 21, namely claims 2-8, 10-16, 18-20, and 22-24, respectively, are also not anticipated by Aras for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 102(b) rejections for claims 1-24 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-29 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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Dated: <u>October 21, 2004</u>   By: _____

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on October 21, 2004.

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Jean Svoboda